



**THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of: Phyllis Liethem et al.

Serial No: 09/863,585

Filed: May 16, 2001

For: **ABSORBENT PRODUCTS AND METHODS OF
PREPARATION THEREOF**

Group Art Unit: 3761

Examiner: J. F. Stephens

I hereby certify that this correspondence
is being deposited with the United States
Postal Service as first class mail in an
envelope addressed to:
Mail Stop Appeal Brief-Patents, Commissioner for
Patents, P.O. Box 1450
Alexandria, Virginia 22313-1450

William Spatz
Name of Applicant, Assignee or Registered
Representative


Signature

November 3, 2008
Date of Signature

**REQUEST UNDER 37 C.F.R. §41.50(b)(2) FOR A REHEARING
OF THE BOARD'S DECISION ON APPEAL**

MAIL STOP APPEAL BRIEF-PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

This is a Request for Rehearing of the Decision on Appeal in the captioned
application dated September 4, 2008 (the "Decision"). This Request is submitted in Triplicate.

The Final Rejection which is under appeal rejected Appellants' Claim as obvious under 35 U.S.C. §103(a) over U.S. Patent No. 3,658,064 to Pociluyko (hereinafter "Pociluyko") in view of U.S. Patent No. 2,083,575 to Novak (hereinafter "Novak"). Appellants submit that the Board's Decision affirming the Examiner's rejection of Claim 104 is improper as the Decision asserts a new ground of rejection.

I. The Examiner's Rejection and Appellants' Arguments

The Examiner rejected Claim 104 under 35 U.S.C. 103(a) as being unpatentable over Pociluyko in view of Novak. Addressing the teaching of Novak, the Examiner stated:

Novak discloses a method for making **fluff pulp** capable of being used for personal hygiene articles, due to its soft and absorbent characteristics (Novak page 2, col. 1, lines 15-20). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Pociluyko with a **fluff pulp made by the method taught in Novak**. Doing so would provide an absorbent product containing **fluff pulp material** that 1) is very soft, absorbent, and easily saturated; and 2) will not deteriorate in storage and can be conveniently shipped to distant point in the same way as in the case of commercial wet pulp (Novak page 1, col. 1, lines 6-12; page 2, col. 2, lines 21-26).

* * * * * Novak further discloses **fluffing the treated wood fiber pulp to form an absorbent sublayer material comprised of fluffed base-treated wood fiber pulp** (Novak page 1, col. 2, line 54 through page 2, col. 1, line 20; page 2, col. 1, line 75- col. 2, line 11). Pociluyko/Novak discloses the sublayer material contains 35-100% fluff (Pociluyko col. 4, lines 54-57). The treated wood fiber pulp of Pociluyko/Novak is not subjected to chemical crosslinking. (*Emphasis Added*)

II. The Board's Decision

In relevant part, the Board found that: "First, the Examiner noted that it was the pulp of Novak, not the final paper product, that would be used in Pociluyko. Second, one of ordinary

skill in the art would know not to make the final paper product from the pulp if a fluffed material was called for.”

Appellants respectfully submit that the Board has misconstrued the Examiner’s rejection. The Examiner did not find that the caustic extracted pulp of **Novak** could be mechanically fluffed and used in the product of **Pociluyko**. Rather, the Examiner found that **Novak’s** wet laid pulp was a **fluffed pulp** which could be directly substituted into the structure of **Pociluyko**. Accordingly, the Board’s conclusion that the Examiner rejected the pending Claim on the basis that caustic extracted pulp of **Novak** could be mechanically fluffed and then used as disclosed in **Pociluyko** is in fact different that the rejection presently asserted by the Examiner. As indicated by the bolded language in the above citation to the Examiner’s rejection, the Examiner incorrectly concluded that the pulp in **Novak’s** felted paper was a fluffed pulp. While the Board’s interpretation of the Examiner’s rejection is a different rejection than that now appealed from, **it is not an entirely new rejection in the present application or even in the present Appeal**. The Examiner, previously rejected the Claim of the basis that the use of fluffed caustic extracted pulp in the claimed personal hygiene devices was anticipated by the prior art, and **withdrew that rejection in this Appeal**.

III. Examiner’s Prior Rejection

In an Official Action issued in this Application on September 19, 2002, the Examiner rejected Claim 104 on the basis that U.S. Patent No. 3,932,209 to **Chatterjee** taught the use of fluffed caustic extracted pulp in absorbent articles. This is essentially the same rejection which the Board now makes by combining **Novak** and **Pociluyko**. Appellants’ argued against this rejection by pointing out that **Chatterjee** actually taught the use caustic extracted pulp which

was mechanically fluffed and chemically cross-linked, and accordingly taught away from the claimed invention which excluded the use of chemically crosslinked pulp. In the same response, Applicant's presented and argued evidence of the surprising results achieved using non-crosslinked caustic extracted fluffed pulp in its claimed product. Notwithstanding these arguments, the Examiner maintained the referenced rejection in a final Official Action issued on June 16, 2003, and Applicants appealed from that final rejection.

In Appellants' first Appeal Brief filed on March 17, 2004, Appellants again argued against the rejection of Claim 104 based on **Chatterjee** and again provided evidence of unexpected results. The Examiner responded by withdrawing this final rejection and substituted the present rejection based on **Novak** and **Pociluyko**.

On August 18, 2004, Applicant's filed a Request for Reinstatement of Appeal and a Supplemental Appellants' Brief, addressing the newly asserted grounds of rejection. Appellants' did not again argue over the **Chatterjee** reference because it had been withdrawn by the Examiner. The Board's finding at page 11 of the Decision that no actual argument has been presented by Appellants with respect to **Chatterjee** teaching away from the use of uncross-linked caustic extract pulp in absorbent personal hygiene devices ignores that such arguments were made in Appellants' first Appeal Brief on March 17, 2004, and that these arguments resulted in the Examiner's withdrawal of the rejection. Accordingly, Appellants' submit that the Board finding in this regard is erroneous.

IV. The Board's Refusal to Consider Appellants' Evidence of Nonobviousness

At page 13 of the Decision, the Board found that Appellants' arguments that the wood fiber pulp covered by its Claim has surprising properties in the claimed products should have

been addressed in its opening Brief, but was not. Appellants respectfully submit that such arguments were submitted in their opening Brief on March 17, 2004 and were implicitly found to be compelling enough for the Examiner to withdraw the then outstanding final rejection of the Claim as anticipated by **Chatterjee**. Further, the Examiner had every opportunity to make a new obviousness rejection based on **Chatterjee** and failed to do so. It is respectfully submitted that the Examiner's action makes it clear that he accepted Appellants' arguments with respect to **Chatterjee** teaching away from the claimed invention and Appellants' evidence of surprising results.

If, for the reasons urged above, the Board is not convinced that it misinterpreted the Examiner's rejection and based its Decision on a new rejection which was not fairly made by the Examiner, and that without good cause it has ignored Appellants' compelling and previously accepted arguments with regard to **Chatterjee** teaching away from the invention, Appellants again respectfully submit that the Board should either consider the evidence of nonobviousness which was first presented in Appellants' opening Brief and again submitted in their Reply Brief, or remand this case to the Examiner so that this evidence of nonobviousness can be expressly considered by the Examiner. However, Appellants' strongly urge that **Novak's** teachings with regard to the properties of wet laid felt are rendered irrelevant by the far more relevant and latter teaching of **Chatterjee** that mechanically fluffed caustic extracted pulp should be crosslinked when used in absorbent personal hygiene devices. In the event that the Board is not convinced, for the Board's convenience, Appellant's evidence of non-obviousness is again presented below.

V. Examples in the Application as Filed Demonstrate the Unobviousness of the Claimed Invention

Prior to the present invention, it was not believed to be possible to achieve the absorption, insult (or re-wetting), liquid retention, softness and pad integrity of modern absorbent composites without employing chemically crosslinked wood fiber pulp. In the production of absorbent devices such as baby diapers, incontinence and catamenial devices and wound dressings (i.e. absorption intensive devices) which contain wood fiber pulp, it has been conventional to use chemical crosslinking to increase the stiffness of the wood fiber pulp fibers, so that a fiber matrix made from them retains its bulk and pore volume when wet, thereby enhancing its absorbency (Specification at page 2, line 16 to page 3, line 10; and U.S. Patent No. 3,932,209 to Chatterjee, Col. 1, lines 35-40). The Specification of the present application at page 2, lines 16 to 22 also references several prior patents directed to the use of chemically crosslinked wood fiber pulp in absorbent composites. The present invention surprisingly discovered that by employing caustic/based treated wood fiber pulp according to the invention, an absorbent composition with desirable absorbency properties for use in personal hygiene devices could be formed without chemically crosslinked wood fiber pulp. The avoidance of chemically crosslinked wood fiber pulp was the expressed objective of the present invention (Specification at page 1, lines 6-12).

The Appellants subjected dozens of pulps to base treatment at a variety of conditions and then subjected those samples to exhaustive testing, including absorbency testing. By this testing, which is referenced in the instant application in the Examples reported at pages 16, 17, 22, 23, 26-32, 39-41, 45-47, 50, 52, 56, 58, 60, 61, 64, 66, 69 and 71, Appellants discovered that wood fiber pulp which is base treated and fluffed has absorbency properties,

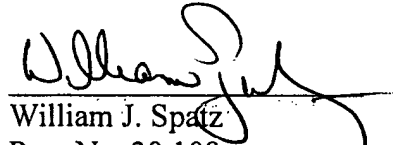
softness and strength which are materially superior to those of conventional fluff pulp, and sufficient to enable its use in the claimed absorbent devices without chemical crosslinking.

VI. Conclusion

In light of the above, Appellants respectfully request that the Decision be withdrawn and that Appellants' Claim be deemed patentable and allowed.

This request is being filed within two months of the date of the Decision pursuant to 37 C.F.R. § 41.52 (a) (1) and therefore no fees are believed due. However, the Commissioner is hereby authorized to credit overpayments or charge any necessary fees to Deposit Account No. 50-0540.

Respectfully submitted,


William J. Spatz
Reg. No. 30,108

MAILING ADDRESS:

Customer No. 31013
KRAMER LEVIN NAFTALIS & FRANKEL LLP
1177 Avenue of the Americas
New York, NY 10036
(212) 715-9257